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J. Michael Neary Aug. 25, 2008
J. Michael Neary Date

Inventor: Eric Thompson)

) Group Art Unit: 3632

Serial No.: 10/620,010)

) Examiner: Steven Marsh

Filed: July 15, 2003)

Title: **"Toolless Locking Mount"**)**August 25, 2008****Brief on Appeal**

Commissioner for Patents
PO Box 1450
Alexandria, VA 22313

Sir,

Applicant submits this Brief on Appeal in furtherance of his appeal from the Final Rejection of claims 12, and 14-18 dated March 24, 2008

1) Real party in Interest

Tcom International, Inc., assignee of this Application, is the real party in interest.

2) Related Appeals and Interferences

Applicant knows of no related interferences or appeals that would directly affect or be directly affected by or have a bearing on the Board's decision in this pending appeal.

3) Status of Claims

Claims 12, and 14-18 were rejected in the Final Office Action as noted in summary fashion below. Claims 1-8 have been allowed.

A. Claims 12 and 14-17 have been rejected under 35 USC 102(b) as anticipated by P/N 4,779,180 to Ruiz.

B. Claim 18 has been rejected under 35 USC 103(a) as unpatentable over P/N 3,049,323 to Peterka in view of P/N 5,438,868 to Holden et al.

4) Status of Amendments

All amendments in this application since prosecution was reopened after the last appeal brief have been entered and considered by the Examiner.

5) Summary of the Claimed Subject Matter

Claim 12. A method of releasably securing an article 8 to a supporting surface against vertical or lateral movement with respect to the supporting surface comprises inserting the article 8 into a space between four mounts 1 (page 5, lines 8-11) that are attached to said supporting surface, with four corners of the article 8 captured between inwardly diverging surfaces of an angled recess 7 in an upstanding base 1 of each mount (Fig. 2; page 4, lines 23-25) to prevent lateral movement of the article relative to the supporting surface.

After the article 8 is fully inserted between the four mounts (page 5, lines 13-15), a top cap 2 on each of the mounts is rotated from an open position (Fig. 2) to a closed position (Fig. 1) over the article 8 to capture the article between the top cap 2 and the supporting surface to prevent vertical movement of the article 8 away from the supporting surface (page 5, lines 15-18).

To remove the article from between the mounts, the resistance of a detent 4, 5, 5A (Fig. 4) that releasably holds the top cap 2 in the closed position (Fig. 1) is overcome, and the top cap of each mount is rotated from the closed position (Fig. 1) to the open position (Fig. 2) away from the article 8 to clear the angled portion 7 and allow lifting of the article from between the four mounts (page 5, lines 19-23).

The article 8 is then lifted from between the four mounts and away from the supporting surface to release the article from the supporting surface (Page 5, lines 22-23).

6) Issues

A. Whether the rejection of claims 12 and 14-17 under 35 USC 102(b) as anticipated by P/N 4,779,180 to Ruiz was proper.

B. Whether the rejection of claim 18 under 35 USC 103(a) as unpatentable over P/N 3,049,323 to Peterka in view of P/N 5,438,868 to Holden et al. was proper.

7) Argument

For simplicity of relating the summary Status of the Claims in §3 and the Statement of Issues in §6 with the related argument in this §8, the same letters used in §§3 and 6 will identify the argument sections.

A. The rejection of claims 12 and 14-17 under 35 USC 102(b) as anticipated by P/N 4,779,180 to Ruiz was improper.

Claim 12 calls for a method of releasably securing an article 8 to a supporting surface against vertical or lateral movement with respect to the supporting surface. The article to be captured is inserted into a space between four mounts that are attached at a bottom surface thereof to the supporting surface (page 5, lines 8-11, with four corners of the article 8 captured between inwardly diverging surfaces of an angled recess 7 in an upstanding base 1 of each mount to prevent lateral movement of the article relative 8 to the supporting surface. The inwardly diverging surfaces of the angled recesses each diverge about a central axis of the base extending between the bottom surface and a top cap 2 atop each of the bases to embrace upright corners of the article.

The top cap 2 is securely held in place releasably by a detent 4, 5, 5A (page 3, line 22) until the resisting force of a detent tending to hold the top cap 2 closed is, overcoming, and the top cap 2 is rotated to allow the object to be lifted vertically away from the supporting surface (page 4, lines 6-22).

Ruiz discloses a device for holding a circular glass cover 4 on a light fitting. It has three columns 2, arranged equidistant from each other around the periphery of a flat circular fitting plate 1 which is attached to a wall. Each column is attached to the fitting plate 1 by screws, shown in Fig. 2. Two of the columns have a sidewardly opening slot 3 facing radially inwardly for receiving the edge of the glass cover 4. The third column 2, shown in Figs. 3 and 4, has a head plate 5 that can be turned to open

the slot 3 for insertion of the glass cover 4, and then turned back to hold the cover in place.

Ruiz has a spring-loaded ball 9 in one of his columns, shown in his Figs. 3 and 4, but this is not a detent. It is merely a spring to support the edge of the glass and hold it snugly in the groove so it does not bang around in there. The spring loaded ball 9 of Ruiz does not hold the head plate 5 in either the open or closed position. Indeed, the spring loaded ball 9 does not even contact or engage the top plate 5 in any way, and does not offer a "resisting force" that must be overcome to open or close the head plate 5. Moreover, the surface in which the spring-loaded ball 9 is mounted (corresponding to the "inwardly diverging surfaces of the angled recesses" in claim 12) does not actually engage the surfaces of the object as claimed in claim 12; the balls 9 do, as shown in Fig. 3.

Thus, Ruiz does not teach these limitations in claim 12. There is no detent in Ruiz and there is no "lifting vertically away from the supporting surface" in that disclosure since that is not how Ruiz functions. Therefore, Applicant believes that amended claim 12 is patentable over the cited references.

There is no serious contention about any of these matters. The Examiner has not asserted that Ruiz discloses all the limitations of claim 12. Lacking prior art that actually discloses the invention claimed in claim 12, the Examiner has chosen to discount many critical limitations by asserting that "Claims 1 and 14-17 contain limitations to the structure of the mounts, but the limitations do not limit the method steps and therefore have no patentable significance." The Examiner thus neatly disposes of the awkward fact that the prior art does not disclose the claimed invention of claim 12.

All method claims have structural limitations. The method always operates on something in the real world. Without structural limitations, the method would be disconnected from the environment in which it is intended to operate. Sometimes the novelty of the method is in the use it makes of particular apparatus or materials, and the structural limitations give meaning to the method steps. There is no reason in logic or the law for ignoring limitations in a claim that is manifestly novel and unobvious over the prior art for mere technical matters of form. As stated in MPEP 706.03:

The primary object of examination of an application is to determine whether or not the claims are patentable over the prior art. This consideration should not be relegated to a secondary position while undue emphasis is given to nonprior art or "technical" rejections.

Claim 14 specifies that the operation of the detent is by compressing a spring 13 when pivoting the top cap 2 to allow the top cap 2 to lift slightly away from the upstanding base 1 so the top cap 2 may be rotated to its open position to allow the article to be lifted out for quick and easy removal. Ruiz has a spring 8 loading a ball 9 to engage the underside of the glass 4 to snugly hold the edge of the glass within a groove 3. Ruiz does not disclose compressing a spring when pivoting the top cap to allow the top cap to lift slightly away from the upstanding base. He does show a spring 7 around a shaft 6 to hold the top plate downwardly into contact with the support part 10, but the top plate does not lift away from the support part 10 when the top plate is rotated, as is claimed in Applicant's claim 14. Indeed, Ruiz does not disclose a detent of any kind. Applicant believes that the function of the spring 7 and the shaft 6, the function of which is described in Col. 2, lines 1-5, is entirely different from the claimed method steps and do not fall within the scope of claim 14. There is no vertical movement of the top cap contemplated by Ruiz in his description of the function of the spring 7 and shaft 6. The function is strictly to engage the underside of the glass 4 to snugly hold the edge of the glass in place in the groove. Hence, claim 14 should be patentable over Ruiz.

Claim 15, dependent on claim 12, calls for moving the inwardly diverging surfaces of the angled recess in the upstanding base of the mount into firm contact with the object. There is nothing whatsoever in Ruiz that would read on this limitation. Applicant respectfully requests that the Examiner address this issue in his Examiner's Answer so that Applicant can respond in his Reply Brief.

Claim 16, dependent on claim 15, calls for the moving step to include moving an angle piece containing the inwardly diverging surfaces of the angled recess against the object. As with claim 15, there is nothing whatsoever in Ruiz that would read on this limitation. Applicant respectfully requests that the Examiner address this issue in his Examiner's Answer so that Applicant can respond in his Reply Brief.

Claim 17, dependant on claim 16, specifies that moving the angle piece includes tightening a screw threaded in the upstanding base to apply pressure against the angle piece. As with claims 15 and 16, there is nothing whatsoever in Ruiz that would read on this limitation. Applicant respectfully requests that the Examiner address this issue in his Examiner's Answer so that Applicant can respond in his Reply Brief.

B. The rejection of claim 18 under 35 USC 103(a) as unpatentable over P/N 4,779,180 to Ruiz in view of P/N 5,438,868 to Holden et al was improper.

Claim 18, dependent on claim 12, calls for the added steps of engaging the article with an elastomeric material such as polyurethane on the inwardly diverging surfaces 7 of the angled recess in the upstanding base to improve the grip of the surfaces on the article and to serve to dampen and isolate vibration between the article and the supporting surface.

Holden teaches an ultrasonic liquid level indicator for liquids within a reservoir to be administered to a patient, to ensure that the reservoir does not run dry. He has a clamp 230 with gripping elements 248 (Fig. 6) for coupling the ultrasonic transducer to the reservoir. The gripping elements 248 are made of elastomeric material such as silicone, polyurethane or rubber so they will grip glass, metal and other smooth surfaces when the clamp 230 is closed around the liquid reservoir.

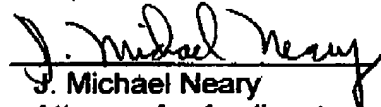
The Examiner asserts that a person of ordinary skill in the art would naturally look to the medical devices art for a teaching of how to improve the grip of the Ruiz' device for holding a circular glass cover 4 on a light fitting. Applicant does not believe that Holden is analogous art with Ruiz and that even if it were, that the teachings in Holden are inapplicable to Ruiz, since the purpose of the polyurethane gripping elements are to grip the glass surfaces to hold the ultrasonic transducer against the reservoir surface. There is no requirement like that in Ruiz. Ruiz' device does not grip the glass cover at all; it merely supports it. There is no requirement for Ruiz' device to grip the glass cover and even the addition of polyurethane on the inwardly diverging surfaces of Ruiz would not "grip" the mirror; they would merely support it passively as before. Moreover, it is not clear how the ball 9 of Ruiz would interact with the polyurethane pads of Holden. These references are not remotely related. Holden

would be of no interest to a person of ordinary skill in the art working on a device like that of Ruiz. Accordingly, Applicant believes that the combination of Holden with Ruiz would not be obvious to a person of ordinary skill in the art. .

Thus, Applicant believes that the claims now pending in this Application all distinguish patentably over the cited references, singly or in combination. Applicant respectfully solicits the Board to reverse the Examiner's rejections and return this Application to him for issuance.

Respectfully submitted,

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